

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/661,159

Confirmation No.: 6784

Applicant(s): Vargas

Filing Date: 12 September 2003

Title: "Shape-Transferring Cannula System
and Method of Use"

TC/Art Unit: 3736

TC Examiner: Hoekstra, J.

Petitions Examiner: Johnson, N.

Docket No.: ENDOV-001/US

Supplemental Petition

Date: 15 June 2010

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Via Electronic Filing System

Sir:

Office of Petitions Examiner Nancy Johnson has asked that Applicant submit a supplemental petition to make portions of the petition filed 24 March 2010 more legible. Accordingly, Applicant submits this supplemental petition that includes (a) the originally filed petition text and Exhibit 1, and (b) portions originally filed as Exhibit 1 enlarged to enhance readability.

Applicant respectfully requests that this petition be granted, that the above-referenced application be revived, and that prosecution be continued in accordance with the papers filed on 24 March 2010.

Text from the originally filed petition.

Applicant respectfully petitions to withdraw a holding of abandonment, because Applicant failed to receive a Notice of Non-Compliant Amendment.

I.

The United States Patent and Trademark Office (the "Office") allegedly mailed a Notice of Non-Compliant Amendment (the "Notice") for this application on 17 November 2009. It appears that this Notice was mailed in response to Applicant's amendment document filed on 7 October 2009. As the Notice appears in the Patent Information and Retrieval System, the Notice states that the amendment document was non-compliant because the claim status identifier "Amended" should instead be "Currently Amended".

II.

In accordance with the information outlined in the Manual of Patent Examining Procedure (8th Ed. Rev. Jul. 2008), § 711.03(c), Applicant provides the following statements and information.

A. The system used to record Office actions at Intuitive Surgical, Inc. begins with the receipt of all mail addressed to the correspondence address of record associated with this application being delivered to a central mail room. There, the mail is sorted by recipient address within the company. Mail from the Office is placed in a mail receptacle for the legal department. At least once each day, a clerk in the legal department retrieves the mail from this receptacle.

Mail from the Office is first opened and examined by employee Anne Killingsworth, who functions as the legal department's docketing clerk. If a paper from the Office indicates that a response is required by a particular deadline, Anne does two things. First, she retrieves the paper file associated with the particular application and clips the paper to the outside of the file. Second, she enters the due date in the legal department's computerized docketing system record associated with the particular application. For situations that require a response be filed within one month of the paper's mailing date, Anne's general practice is to call one of the legal department's patent attorney's immediate attention to the paper. Anne prepares action due lists for all deadlines entered into the legal department's computerized docketing system, and she provides these lists to the appropriate legal department attorney.

B. The legal department uses the computerized Dennemeyer Intellectual Asset Management System (DIAMS) version 8.04.09.4, provided by Dennemeyer & Co., to record due dates associated with papers received from the Office. This is a reliable system. Entry data for each patent application includes the Office's application number, the corresponding attorney docket number, and the due date for any response required by a paper received from the Office.

C. To the best of the undersigned attorney's information and belief, the Notice was not received at Intuitive Surgical, Inc. The undersigned attorney has searched the legal department mail receptacle in the mail room and the surrounding area (e.g., under the receptacle shelves in case the Notice had somehow fallen), the shelf area in which the paper record associated with this application is kept, and the contents the paper record associated with this application but was unable to find the Notice.

D. To the best of the undersigned attorney's information and belief, the legal department first learned that the Notice had been mailed when the legal department received a Notice of

Abandonment that the Office appears to have mailed on 19 February 2010. Upon receipt of this Notice of Abandonment, Anne Killingsworth accessed the Office's Patent Application Information Retrieval system and was able to download a copy of the Notice of Non-Compliant Amendment.

E. To the best of the undersigned attorney's information and belief, the docketing system does not provide a "master docket for the firm" for a particular date range in any usable form. In lieu of such a "master docket", attached to this Petition as Exhibit 1 are (i) an image of the portion of the docketing system record that is associated with this application's identifying details, and (ii) two images that show the portion of the docketing system record that is associated with this application's due dates (completed and pending). These images indicate that the due date associated with the Notice was not entered into the legal department's docketing system, and they are submitted as further evidence that the Notice was not received. The images show that some portion of the record associated with this application was updated on 24 November 2009, but again, there is no evidence that any due date associated with the Notice was entered. After discussing this matter with Anne Killingsworth, the undersigned attorney was unable to determine what portion, if any, of this record was updated on 24 November 2009.

III.

Applicant respectfully petitions the Director under 37 C.F.R. § 1.181(a) to withdraw the holding of abandonment. Accordingly, Applicant believes that no petition fee is due.

If, however, the Office determines that this Petition is more correctly made under 37 C.F.R. § 1.137(a) or 1.137(b), then to speed handling of this Petition the Office is authorized to deduct from Deposit Account No. 503404 \$540.00 (for § 1.137(a)) or \$1620.00 (for § 1.137(b)) as may be necessary.

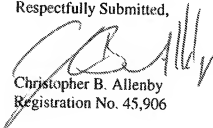
In addition, the Office is authorized to deduct from Deposit Account No. 503404 any additional fees that may be due to reopen prosecution of this application. Large entity fees apply.

IV.

Applicant includes with this Petition a corrected version of the amendment paper filed 7 October 2009. This corrected version includes the correct claim status identifiers for all claims.

Applicant respectfully requests the Director grant this petition. Please contact the undersigned attorney at 408-523-2460 if there are any questions.

Respectfully Submitted,



Christopher B. Allenby
Registration No. 45,906

Exhibit I

Docket System Images

This is the "Patent Details" page from the assignee's DIAMS record that is associated with this application:

DIAMS

File Main Menu Reports Utilities Research Windows Help

DIAMS - Patent Management (Newsworthy)

Docket ID: END0001AUS Short Title: CANNULA SYSTEM & METHOD OF USE
 Client/Business Unit: Applicant/Patentees Other Party ☐
 Attorney: ALLENDY CHRISTOPHER Cost Centers:
 Related Matters: Inventors: LABORATORIES
 VARGAS JAIME S

Invention | Disclosure | Disclosure 2 | Prior Art | Names | Patent Details | Additional Info | Docs Link | Docketing

Country: Convention: Type: Application No: 10/661159 Application Date: 12-Sep-2003
 Region: Pmt. Claimed: Patent: Grant No: Grant Date:
 Status: Independent Claims: Request Search Date: 1st Publication No: 2004-0064322 1st Publication Date: 18-Mar-2004
 Pending: Dep. Multi Dep. Request Exam. Date: 2nd Publication No: 2nd Publication Date:
 Sub Status: Published:

Claimed Priorities & Parent Records

Priority: END0001PLOWAUS 12-Sep-2002 ☒

File Status Abandoned Date: 06-Aug-2007 Expiration Date: 12-Sep-2023
 File Ref: Last Annulity Paid: Next Annulity Due:
 Annulity Instructions: Calculate Expiration to Annulity Freshman

Received: 10/661159-001
 Received 10/661159-001
 10/661159-001
 22-Jun-2010

Ready

This is the first of two images that show docket entries (due and completed) currently in the DIAMS system that are associated with this application. Note that the current assignee purchased this application after it had been filed and prosecution begun, and so not all docket entries associated with the full history of this application are shown. Note also that although this record was last updated on 24 November 2009 (the update information appears near the bottom of the image), no docket entry appears for the Notice of Noncompliant Amendment.

DIAMS

File Main Menu Reports Utilities Research Windows Help

DIAMS Patent Management (View Only)

Docket ID: [ENDOV001]US Short Title: CANFIELD SYSTEM & METHOD OF USE Other Party: ☐

Client/Business Units: _____ Applicant/Patentees: _____

Attorneys: ALLENBY CHRISTOPHER Cost Centers: _____

Related Matters: Inventors: VARGAS JAINE S Laboratories: _____

Invention | Disclosure | Disclosure 2 | Prior Art | Names | Patent Details | Additional Info. | Docs Link | Docketing

Phase: ☐ NYF ☐ Pending ☐ Grant ☐ All ☒ Events ☒ To Do ☒ Date Subphase: From To

Phase	Event	Date	Subphase	From	To
Application Date		10/661159		12-Sep-2003	18-Nov-2007
PRI1 First		2004-005432		18-Mar-2004	20-Oct-2008
OA1 Mail Date				17-Feb-2006	15-Nov-2007
Final OA Mail Date				01-Nov-2006	15-Nov-2007
ADVISOR CPBBOG				21-Feb-2007	15-Nov-2007
Abandoned Date				06-Aug-2007	15-Nov-2007
Restriction Requirement Mail Date				29-Oct-2008	04-Nov-2008
IOS VERT & ATTY				12-Nov-2008	17-Nov-2008
Idc etty				12-Dec-2008	17-Dec-2008
not				29-Dec-2008	08-Dec-2008
OA2 Mail Date				07-Feb-2009	09-Apr-2009
Expiration Date				12-Sep-2023	15-Nov-2007
OA1 Response Due				17-May-2006	15-Nov-2007
Final Resp. Due: 2 Nov 2006				01-Dec-2006	15-Nov-2007

Record 1

Created 10-Nov-2009 10:00:00 AM

Updated 24-Nov-2009 10:00:00 AM

24-Nov-2009

Ready

NUM

This is the second of two pages that show docket entries (due and completed) currently in the DIAMS system that are associated with this application.

DIAMS Patent Management (View-only)

File Item Menu Reports Utilities Research Windows Help

Docket ID: ENDO001JUS

Short Title: CANINE SYSTEM & METHOD OF USE

Client/Business Units: [Empty]

Applicant/Patentees: [Empty]

Other Party: [Empty]

Attorneys: ALLENBY CHRISTOPHER

Cost Centers: [Empty]

Inventors: VARGAS JADIE S

Laboratories: [Empty]

Related Matters: [Empty]

Invention | Disclosure | Disclosure 2 | Prior Art | Names | Patent Details | Additional Info | Docs Link | Docketing

Phase: ☒ MFP ☐ Pending ☐ Grant ☐ All ☒ Events ☒ To Do ☒ Done

Subphase: [Empty] From: [Empty] To: [Empty]

Event	Due Date	From	To
ent	29-Dec-2008	05-Dec-2008	
OA2 Mail Date	07-Apr-2009	09-Apr-2009	
Expiration Date	12-Sep-2023		
OA1 Response Due	17-May-2006	13-Aug-2006	42491
Final Resp. Due - 2 Mo Rem	01-Dec-2006		15-Nov-2007
Final Resp. Due - 1 Mo Rem	01-Jan-2007		15-Nov-2007
Response to Provoked Advisory Action	01-Jan-2007	30-Jan-2007	42491
Final Response Due	01-Feb-2007		15-Nov-2007
Final Resp. Due - 1 Mo Ext	01-Mar-2007		15-Nov-2007
Final Resp. Due - 2 Mo Ext	01-Apr-2007		15-Nov-2007
Final Resp. Due of Appeal Due - FINA	01-May-2007		15-Nov-2007
Restriction Requirement Resp. Due	29-Nov-2008	12-Nov-2008	42491
OA2 Response Due	07-Jul-2009	07-Oct-2009	42491

Retard 4 2/5 Created 15-Nov-2007 AMER Updated 22-Nov-2008 AMER 22-Nov-2010

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***** Last Item *****

Supplement to Exhibit I

This supplement enlarges the docket system images in the petition filed 24 March 2010.

Applicant believes these enlarged images are legible and suitable for consideration.

This is the "Patent Details" page from the assignee's DIAMS record that is associated with this application:

DocId: 10349-2037 File Main Menu Reports Utilities Research Windows Help		Patent Information (Patent Information) Short Title CANELLA SYSTEM & METHOD OF USE Client/Owner/Assignee ALTERNIA RALEIGH CHRISTOPHER Inventors MARGAS JUNE S		Other Party Applicants/Parties Cost Centers Laboratories	
Related Matters Patent ID ENDO1001165		Additional Info. Doc Link Docking		Application Date 12-Sep-2003 Grant Date	
Invention Disclosure Disclosure 2 Prior Art Names Conversion PFI Claimed Origin Sub Type		Patent Details Type Patent Sub Type		Application No 101661159 Grant No	
Status Pending Sub Status Pushed		Independent Claims Request Search Date Request Exam. Date Dep. Multi Dep.		1st Publication Date 12-Mar-2004 2nd Publication Date 1st Publication Date 08-Aug-2007 Last Annulity Paid Next Annulity Due	
Claimed Priorities & Parent Records Priority ENDO1001165/US 12-Sep-2002		File Status File Ref Amnuty Instructions		Abandoned Date 08-Aug-2007 Last Annulity Paid Next Annulity Due	

This is the first of two images that show docket entries (due and completed) currently in the DIAMS system that are associated with this application. Note that the current assignee purchased this application after it had been filed and prosecution begun, and so not all docket entries associated with the full history of this application are shown. Note also that although this record was last updated on 24 November 2009 (the update information appears near the bottom of the image), no docket entry appears for the Notice of Noncompliant Amendment.

DIAMS File Main Menu Reports Utilities Research Windows Help

DIAMS Docket Entry System (Web GUI)

Docket ID: END0001/US Short Title: CANULA SYSTEM & METHOD OF USE
 Class/Inventor: Chem/Business Units

Related Matters: **Attorneys: ALLENBY CHRISTOPHER**
Inventors: VARGAS JAUME S

Applicant/Assignees: Other Party:
 Cost Contests:
 Laboratories:

Phase: ☒ INF ☐ Pending ☐ Grant ☐ All ☐ Events ☒ To Do ☒ Done

Subphase: From: To:

Additional Info: Doc Link: Docketing:

Phase	Subphase	From	To
INF	Application Date	10/661159	12-Sep-2003
INF	Publi First	2004-005432	15-Nov-2007
INF	Final OA Mail Date		20-Oct-2004
INF	Final OA Mail Date		17-Feb-2006
INF	ADVISOR OPINION		01-Nov-2007
INF	Abandoned Date		15-Nov-2007
INF	Restriction Requirement Mail Date		06-Aug-2007
INF	IDS VERT & ATTY		29-Oct-2008
INF	IDS atty		12-Nov-2008
INF	ext		17-Dec-2008
INF	OA2 Mail Date		29-Dec-2008
INF	Expiration Date		07-Apr-2009
INF	OA1 Response Due		12-Sep-2003
INF	Final Exam Due - 2 Mo Rem	17-May-2006 13-Aug-2006	42491
INF	Final Exam Due - 2 Mo Rem	01-Dec-2006	15-Nov-2007
INF	Final Exam Due - 2 Mo Rem		15-Nov-2007

Record: Last Modified: 15-Nov-2007 10:00:00 AM
 Updated: 24-Sep-2009 10:00:00 AM

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DIAMS File Main Menu Reports Utilities Research Windows Help

DIAMS Patent Management Client only

Docket ID: **END000115** Short Title: **CANULA SYSTEM & METHOD OF USE** Other Party: ☐

Client Business Units: **Attorneys: ALLENBY CHRISTOPHER** Agents/Patentees: **Cost Centers:** **Laboratories:**

Related Matters: **Inventors: VARGAS JAMES S**

Invention Disclosure 2 | **Prior Art** | **Names** | **Parent Details** | **Additional Info.** | **Docs Link** | **Docketing**

Phase: ☒ NMF ☐ Pending ☐ Grant ☐ All ☐ Events ☒ To Do ☒ Done

Subphase: **2003** From: **05-Dec-2008** To: **05-Dec-2008**

Event	Due Date	From	To
CAZ Mail Date	05-Dec-2008		
Exam Return Date	09-Apr-2009		
CAZ Response Due	12-Sep-2003		
Final Resp. Due - 2 Mgs Plan	17-May-2006	13-Aug-2006	42491
Final Resp. Due - 1 Mgs Plan	01-Jan-2007		
Response to Priority & Discovery Action	01-Jan-2007	30-Jan-2007	42491
Final Resp. Due	01-Feb-2007		
Final Resp. Due - 1 Mgs Plan	01-Mar-2007		
Final Resp. Due - 2 Mgs Plan	01-Apr-2007		
Final Resp. Due - 2 Mgs Plan	01-May-2007		
Final Resp. Due - 2 Mgs Plan	29-Nov-2008	12-Nov-2008	42491
Final Resp. Due - 2 Mgs Plan	07-Jul-2009	07-Oct-2009	42491

Record 4 of 25 | Standard | Refresh | Search | Updated: 26-Nov-2009 | Higher | 26-Nov-2009 | 10:41

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